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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,311	03/02/2005	Melchor Daumal Castellon	001058-00023	3822
27557 7590 09/02/2008 BLANK ROME LLP 600 NEW HAMPSHIRE AVENUE, N.W. WASHINGTON, DC 20037				
EXAMINER				
KELLY, CATHERINE A				
ART UNIT		PAPER NUMBER		
3634				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/526,311

**Applicant(s)**

DAUMAL CASTELLON, MELCHOR

**Examiner**

CATHERINE A. KELLY

**Art Unit**

3634

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the claimed parts of applicant's invention are difficult or in some cases impossible to discern in the present drawings. Most notably, the upper portion of the drawings containing the frame is shaded to dark to see the first slider in the frame. Also, the location of the points of contact should be demarcated in a better manner as it is difficult to discern if there are 3 or 5 points and the location of the rightmost point is obscured by the shaded portion on the right in the door body. Further, as the slider in the frame cannot be seen, neither can the point of contact be seen. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for driving must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the point of contact of the first guide and slider assembly must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the lock must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

***Specification***

35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: "points of contact". The specification does not clarify the location of the points of contact nor what is contacting what at said points. Also, the term "means for driving" is used but the clarification of what means are used is not present as possible driving means in the specification are a motor and screw shaft listed on page 6, a drum and lift cable listed on page 8, or an electric motor and gearmotor listed on page 9. Further, the term "suppress" is used in the specification of page 6 in view of the lock motor. The use of this term in the specification does not convey meaning to a native English speaker. Is the means for driving slowing the lock? Stopping the lock from working? Replacing one of the lock motors with the driving means? Applicant should carefully review the specification, including the claims, and revise any unclear language so that the claimed subject matter is clear.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "the design of said window lift assembly" is indefinite and conveys insufficient meaning to the reader. Is the window assembly planned to do something? Is the window assembly decorative? The word design should be replaced with a more specific word, such as —structure— or —specifics— conveying a better idea of the invention to the reader.

Claims 4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As stated in the above objections to the specification, the word "suppress" in relation to the locking means conveys no definite meaning. For purposes of examination, Examiner will read "suppress" as "connected to" as connected to is the only definite meaning taught in the specification and claims.

Numerous claims, including 1, 5, 6, recite "as low as possible" or "as high as possible". This is unclear – infinity is as high as possible, 0 is as low as possible. For example, claim 5 – how would one know how high or low was possible?

Claim 2 recites "low". The term "low" in claim 2 is a relative term which renders the claim indefinite. The term "low" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

While claims can be broad, examiner does not know how to tell the limits of claim 7 – “the values depend on the geometry and the loads of the assembly”. How would one know what this meant and if a device infringed on it? There must be a way to determine the limits and bounds of the claim-- it can not be limitless. This is the same issue as with “high as possible” etc discussed with claims 1,5, and 6.

Looking at claim 1, all examiner can determine is that applicant is giving the parameters that can determine the window lift assembly design. Applicant is claiming the assembly – the parameters the assembly is based on do not define the assembly-- values or structure must be given.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

As best understood, Claims 1-3, 6, 8, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PG Pub 2002/0095870 in view of DE10057352. The '870 reference shows the mechanism of claims 1-3 in figure 1 with track 11, the track slider assembly 43, and driving means 15 and in figure 2 where the disassembled door is shown but not numbered and the door or pane frame 53 contains pane 41. However, the '870 reference does not teach the guide and slider of the frame of the present invention. This is shown in the '352 reference in figure 1 reference numeral 7. It would have been obvious to one of ordinary skill in the art at the time. One of ordinary skill would be motivated to combine because a dual slider assembly was clearly known in the art at the time of invention and a second slider would provide additional control over and stability to the assembly which is always desirable in the art. The '870 reference does not teach the various values and equations of claims 1-3, however, these values and equations are obvious design choices that would be obtained with only routine experimentation by one of ordinary skill in the art at the time of invention and as such the points of contact as claimed would be determined based on the design choice and as such would be wherever would be appropriate. One of ordinary skill in the art would be motivated to make such design choices based on a variety of parameters such as the size of the vehicle in which the assembly is to be placed or the need for minimal cost or maximum speed in manufacturing.

Regarding claim 6, the fitting of the assembly in the frame is taught in the '870 reference in paragraph [0052] and shown in figure 3 and the first guide fitting in the frame shown in the '352 reference in figure 1 where the slider is reference numeral 7

and frame 8. The fit shown in the '870 reference is tight enough to prevent rotation in combination with the slider of the '352 reference.

Regarding claim 8, the window lift assembly is shown in the '870 reference in figure 1 with track 11 and the track slider assembly 43 and in figure 2 where the disassembled door is shown but not numbered and the door or pane frame 53 contains pane 41. However, the '870 reference does not teach the guide and slider of the frame of the present invention. This is shown in the '352 reference in figure 1 reference numeral 7.

Regarding claim 9, the driving means is shown in the '870 reference in figure 1 reference numeral 15.

Regarding claim 12, the fitting of the assembly in the frame is taught in the '870 reference in paragraph [0052] and shown in figure 3 and the first guide fitting in the frame shown in the '352 reference in figure 1 where the slider is reference numeral 7 and frame 8. The fit shown in the '870 reference is tight enough to prevent rotation in combination with the slider of the '352 reference.

As best understood, Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0095870 and DE10057352 as applied to claims 1 and 8 above, and further in view of US patent 5715630. The connection of the assembly in the lock with the track secured to the lock is taught in paragraph 13 of the '870 reference. However, while the '870 reference shows a lock assembly connected to the rail of the window guide member, it does not teach the connection of lock assembly and window lift driving means of claim 4. The '630 does teach this connection in column 2



lines 21-25 and 30-31. It would have been obvious to combine to one of ordinary skill in the art at the time of invention. A motivation for such combination is given in the '630 reference in column 2 lines 37-40 which teaches that the connection of the lock and the rail allows for compensation for manufacturing tolerances.

Regarding claim 10, the connection of the assembly in the lock with the track secured to the lock is taught in paragraph 13 of the '870 reference. However, while the '870 reference shows a lock assembly connected to the rail of the window guide member, it does not teach the connection of lock assembly and window lift driving means. The '630 does teach this connection in column 2 lines 21-25 and 30-31. It would have been obvious to combine to one of ordinary skill in the art at the time of invention. A motivation for such combination is given in the '630 reference in column 2 lines 37-40 which teaches that the connection of the lock and the rail allows for compensation for manufacturing tolerances.

As best understood, Claims 5, 7, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0095870 and DE 10057352 as applied to claims 1 and 8 above, and further in view of US patent 3591983. The slider of the '352 reference does not have either the rotation of claims 5 and 11 or the single point of claims 7 and 13. However, both of these limitations are shown in the '983 reference where figure 2 shows follower 46 which is both attached at a single point and rotatable. It would have been obvious to combine to one of ordinary skill in the art at the time of invention. A motivation for such combination is given in the '983 reference in column 1 lines 22-26

which teaches the advantages of a minimal number of fastening points while still allowing for rotation to permit adjustment or maintenance of the apparatus.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CATHERINE A. KELLY whose telephone number is (571)270-3660. The examiner can normally be reached on Monday through Friday 8am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katherine Mitchell can be reached on 571-272-7069. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. K./  
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